

REMARKS

In the Office Action¹, the Examiner:

1. rejected claims 1, 3, 4, 6-10, 12, 14-18, and 23-26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Pub. No. 2002/0184401 to Kadel et al. ("*Kadel*") in view of U.S. Patent Application Pub. No. 2005/0005261 to Severin ("*Severin*") and further in view of U.S. Patent Application Pub. No. 2003/0149934 to Worden ("*Worden*"); and
2. rejected claims 20-22 under 35 U.S.C. § 103(a) as being unpatentable over *Kadel*, *Severin*, *Worden*, further in view of U.S. Patent No. 6,920,461 to Hejlsberg et al. ("*Hejlsberg*").

By this Amendment, Applicant has amended claims 1, 10, 18, 24, and 25 to more specifically point out and clarify the claimed invention. No new matter has been added.

Applicant respectfully requests reconsideration and withdrawal of the rejections, and timely allowance of the pending claims for at least the reasons set forth below.

Rejection of Claims 1, 3, 4, 6-10, 12, 14-18, and 23-26 under 35 U.S.C. §

103(a)

Applicant respectfully traverses the rejection of claim 1, 3-4, 6-10, 12, 14-18, and 23-26 under 35 U.S.C. § 103(a) as being unpatentable over *Kadel* in view of *Severin* and further in view of *Worden*. A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). "[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v.*

¹ The Office Action may contain statements characterizing the related art, case law, and claims. Regardless of whether any such statements are specifically identified herein, Applicant declines to automatically subscribe to any statements in the Office Action.

John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966). The factual inquiries...[include determining the scope and content of the prior art and]...[a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). In rejecting a claim, “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III). In this application, a *prima facie* case of obviousness has not been established because the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed combinations.

Independent claim 1 calls for a combination including, for example, “a computer program product for deriving a metadata API from a metamodel in order to develop an application...being operable to... generate code using the set of intermediate objects as inputs to derive an API enabling development tools to access the development objects to develop the application.” (emphasis added). *Kadel* does not teach or suggest at least these features of independent claim 1.

The Office Action alleges that the InfoModel 350 of Figure 3A of *Kadel* constitutes the claimed features of “receiv[ing] the metamodel in a first language, the metamodel describing a diagram of classes that define one or more development objects...for developing the application.” (Office Action at page 2). However, the InfoModel 350 exists within *Kadel*’s mediation layer/API 112. (*see Kadel*, ¶ [0109]; emphasis added). Therefore, API 112 is not derived using a set of intermediate objects as inputs, as recited in claim 1. Because of this, API 112 does not “enable development tools to access the development objects to develop the application,” as recited in claim

1. Instead, *Kadel's* API 112 allows data source component 102 to access data consumer component 122, neither of which are "development tools," as claimed. Any communication between data source component 102 and data consumer component 122 is used for an existing application to function (see *Kadel*, ¶ [0094]), and is not used to "develop the application," as recited in claim 1 (emphasis added). Moreover, *Kadel* is silent with respect to any aspect of generating API 112, and therefore, fails to teach or suggest an apparatus configured to "generate code using the set of intermediate objects as inputs to derive an API," as recited in claim 1 (emphasis added).

The Office Action alleges that *Kadel* teaches a JAF API that "creat[es] code in the API enabling development tools to access development objects" and that this reads on the claimed "generate code using the set of intermediate objects as inputs to derive an API" (Office Action at page 3; emphasis added). However, this is not correct. In *Kadel*, the JAF API is not "derived by generating code using the set of intermediate objects as inputs" as discussed above. Therefore, *Kadel* fails to teach or suggest an apparatus configured to "generate code using the set of intermediate objects as inputs to derive an API" as recited in claim 1 (emphasis added).

Severin and *Worden* do not compensate for the deficiencies of *Kadel* as discussed above. That is, *Severin* and *Worden* also do not teach or suggest at least "a computer program product for deriving a metadata API from a metamodel in order to generate an application...being operable to... generate code using the set of intermediate objects as inputs to derive an API" as recited in independent claim 1.

In view of the above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior

art and the claimed invention. Moreover, the Office Action has failed to clearly articulate a reason why the claims would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for independent claim 1. Independent claims 10 and 18, while of different scope than claim 1, distinguish over *Kadel*, *Severin* and *Worden* for reasons similar to claim 1. Claims 3, 4, 6-9, 12, 14-17, and 23-26 are patentable at least due to their dependence from one of the allowable independent claims.

Rejection of Claims 20-22 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 20-22 under 35 U.S.C. § 103(a) as being unpatentable over *Kadel*, *Severin*, and *Worden*, further in view of *Hejlsberg*. A *prima facie* case of obviousness has not been established.

As discussed above, *Kadel*, *Severin*, and *Worden* do not teach or suggest at least “computer program product for deriving a metadata API from a metamodel in order to develop an application...being operable to... generate code using the set of intermediate objects as inputs to derive an API wherein the API enables development tools to perform operations on the development objects to develop the application,” as recited in independent claim 18. *Hejlsberg* does not compensate for the deficiencies of *Kadel*, *Severin*, and *Worden* as discussed above. That is, *Hejlsberg* also does not teach or suggest at least “computer program product for deriving a metadata API from a metamodel in order to develop an application...being operable to... generate code using the set of intermediate objects as inputs to derive an API wherein the API enables development tools to perform operations on the development objects to develop the application,” as recited in independent claim 18, from which claims 20-22 depend.

In view of the above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Moreover, the Office Action has failed to clearly articulate a reason why the claims would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for claims 20-22 at least due to their dependence from allowable independent claim 18.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 

Jeffrey A. Berkowitz
Reg. No. 36,743
(202) 408-4000

Philip J. Hoffmann
Registration No. 46,340